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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,770	08/05/2003	Adalberto M. Ramirez	QLTIP008	1701
22434	7590	09/23/2005	EXAMINER	
BEYER WEAVER & THOMAS LLP P.O. BOX 70250 OAKLAND, CA 94612-0250			TRINH, MINH N	
			ART UNIT	PAPER NUMBER

3729

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/635,770

Applicant(s)

RAMIREZ ET AL.

Examiner

Minh Trinh

Art Unit

3729

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2003.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-18 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/8/2004.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The title of the invention is too long the following title is suggested: "Tool for device under test boards".

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "38" and "52" have both been used to designate the same part. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

It is also noted that reference characters "38" has been used to designate a number of different parts (i.e., see Fig. 3, shows that 38 being used to represent shorting contact and stop pins).

Claim Objections

3. Claims 2-18 are objected to as being of improper dependent form the following languages are suggested:

"A tool" (claims 2-18, line 1) should be changed to:-- The tool--, as so to reflect the dependent claim formats.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The scope of the claim is unclear because claims directed to both tool and a DUT boards, in formulating of the rejection. In formulating a rejection on the merits, the examiner is considering that the claims are drawn to a tool and not a combination of both and the claims will be rejected accordingly.

"the board" (claim 1, lines 2-3) lacks proper antecedent basis.

It is not known whether "a DUT board" (claim 1, line 5 and line 8, claims 4 and 6, line 2, as same as "DUT boards" which recited in line 1.

What being referring as "an electronic device" (claim 1, lines 7), and if this is as same as "electronic devices under test" (in the preamble)? Please clarify.

The scope of claims 6-11 and 17-18 is not clear because it is clearly that claims directed to tool but not the associated elements i.e., "DUT board" therefore the structure

that make up the DUT board does not seem to be further limiting the claimed "tool" to which the invention is about.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-2 and 12-18 as best understood are rejected under 35 U.S.C. 102(b) as being anticipated by Oster et al (5,793,218).

A tool for handling electronic devices under test (DUT) boards, where a device plugs into a socket on one side of the board and socket connectors can be electrically accessed from the other side of the board, the tool comprising:

a support frame 20, guides on one side of the frame 62 for slidably receiving a DUT board 18 (see Fig. 2), and at least one electrical shorting connector 58 extending from the frame and electrically contacting and shorting socket connectors and leads of an electronic device when a DUT board is inserted into the guides (see an arrow of Fig. 2).

As applied to claim 2 (see the discussion at col. 4, lines 50-67) that the frame being connected to the shorting contact by material or pad 52 (see Fig. 2).

Limitations of claims 12-14 and 15-16, the Oster et al reference discloses the limitations of these claims where the frame includes a handle and connector for

receiving at least one of the DUT boards and the guide having stop 62 for limiting the travel of the DUT boards, etc (see Fig. 2).

As applied to claims 17-18, limitations of claims 17-18 are directed to a subcombination i.e., DUT board which does not further limit the tool (see paragraph 5 above). Additionally, the Oster et al reference does shown the DUT board having the configurations as recited in these claims (see Figs. 2 and 8, depicts the DUT board and connector, associated therefrom).

8. At least claims 1-2 and 12-18 as best understood are also rejected under 35 U.S.C. 102(b) as being anticipated by Steketee (6,170,329).

Steketee discloses the tool recited in these claims as depicted in the Figs. 1-2, the for handling electronic devices under test (DUT) boards comprising: a support frame 45, guides on one side of the frame 55 for slidably receiving a DUT board 20 (see Figs. 1-2), and at least one electrical shorting connector 35 or 40 extending from the frame (see related Fig. 3 shows the shorting socket) and electrically contacting and shorting socket connectors and leads of an electronic device when a DUT board 15 when inserted into the guides (see an arrow of Fig. 2).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3-11 as best understood is rejected under 35 U.S.C. 103(a) as being unpatentable over Oster et al.

As applied to claim 3, Oster et al is silent about the conductive material is being aluminum. However, it would have been an obvious matter of design choice to choose any conductive materials for electrically connecting purpose since applicant has not disclosed that the use of aluminum materials as recited in claim 3 is critical, patentably distinguishing features and it appears that the invention would perform equally well with the conductive material as trace as shown in the prior art reference (see reference 52 of the Oster et al reference). Further, Aluminum as conductive material is old and well known in the art. One having skill in the art at the time of the invention was made would know to use the available conductive material including aluminum for purpose of connecting in order to form an electrically connection between the connector and its associated member, etc.

As applied to claims 4-6, Oster et al discloses the limitations of these claims where the frame includes a handle and connector for receiving at least one of the DUT boards and the guide having stop 62 for limiting the travel of the DUT boards, etc (see Fig. 2).

As applied to claims 7-11, limitations of claims 7-11 are directed to a subcombination i.e., DUT board which does not further limit the tool (see paragraph 5 above). Additionally, the Oster et al reference does shown the DUT board having the

configurations as recited in these claims (see Figs. 2 and 8, depicts the DUT board and connector, associated therefrom).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited for the teachings of tool for electronic DUT board or the like.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Trinh whose telephone number is (571) 272-4569. The examiner can normally be reached on Monday -Thursday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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mt

9/20/05

A handwritten signature in black ink, appearing to read 'Minh Trinh', followed by a horizontal line.

Minh Trinh
Primary Examiner
Group 3700